REMARKS/ARGUMENTS

This Amendment is prepared in response to a Final Office Action dated May 24, 2004. In the Final Office Action, claim 1, 7, 10, 16, 19, 25, 28 and 34 were rejected under 35 U.S.C. §102(e) as being anticipated by Lawler (USP 5,758,259). In addition, claims 1, 2, 6, 9-11, 15, 18-20, 24, 27-29, 33 and 36 were rejected under 35 U.S.C. §102(e) as being anticipated by Wugofski (US 2003/0056216 A1) and claims 1, 10, 19 and 28 were rejected under 35 U.S.C. §102(e) as being anticipated by Wehmeyer (USP 5,867,226). Moreover, claims 3, 12, 21 and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Wugofski in view of Perlman (USP 5,583,576), (ii) Lawler in view of Perlman, and (iii) Wehmeyer in view of Perlman. Claims 4, 13, 22 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Wehmeyer in view of Levitan (USP 5,534,911), (ii) Wugofski in view of Levitan, and (iii) Lawler in view of Levitan. Claims 5, 14, 23 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Lawler in view of Towell (USP 6,647,411) and (ii) Wugofski in view of Towell. Claims 8, 17, 26 and 35 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Wugofski in view of Zahavi (USP 5,410,367), (ii) Wehmeyer in view of Zahavi, and (iii) Lawler in view of Zahavi. Applicant respectfully traverses these rejections in their entirety.

On July 20, 2004, a telephone conference was conducted between the undersigned attorney, Examiner Chung, and his supervisor Examiner Grant. Both Examiners are thanks for their time in discussing this matter with the undersigned attorney.

The discussion of the telephone conference focused on the allowability of claim 7. For the record, the undersigned attorney cannot comment on the complete telephone conference since he was not privy to any conversations held by the Examiners when the undersigned attorney was placed on "hold". In general, the telephone conference did not facilitate prosecution of the subject application because the arguments presented by both parties clearly indicated that a formal request for reconsideration would be warranted.

Most notably, the undersigned attorney presented arguments that Lawler does not describe or even suggest the prevention of "rollover" as set forth in dependent claim 7. "Rollover" is defined on page 16, lines 8-14 of the subject application as an occurrence where the count values in memory approach its maximum count value and resets. Clearly, this may cause an error to occur to the list of favorites. The prevention of rollover can be accomplished by using relative statistics.

In response, Examiner Grant asserted that the position of the USPTO was that rollover is "prevented" because the viewer preferences table does not experience rollover, and thus, prevents it. The undersigned attorney adamantly disagreed. After continued discussions and a verbal confirmation that this was, indeed, the position of the USPTO, no agreement concerning the allowability of dependent claim 7 and similarly situated dependent claims could be reached.

As a result, Applicant respectfully requests reconsideration of the allowability of claims 7, 16, 25 and 34 as well as those claims dependent thereon. Claims 7, 16, 25 and 34 have been placed into independent form to include limitations from independent claims 1, 10, 19 and 28,

respectively. Claims 7, 16, 25 and 34 have not been narrowed upon placing in independent form. Claims 1, 10, 19 and 28 have been cancelled without prejudice. The dependency of claims 2-6, 8-9, 11-15, 17-18, 20-24, 26-27, 29-33 and 35-36 has been revised accordingly.

The only outstanding rejection directed to claims 7, 16, 25 and 34 is the §102(e) rejection based on Lawler. Applicant respectfully contends that a *prima facie* case of anticipation as not been established.

As the Examiner is aware, to anticipate a claim under 35 U.S.C. §102(e), Lawler must teach each and every element of the claims. "A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference." Verdegall Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully submits that Lawler does not describe "preventing rollover of a count value." Instead, Lawler teaches a "least recently used" (LRU) substitution technique for a viewer preference table as set forth on column 8, lines 5-44 of Lawler. *See page 8 of the Final Office Action.* The least recently used (LRU) substitution technique as applied to the viewer preference table (Table 2) does not constitute an operation that prevents rollover. Moreover, the absence of any express or inherent discussion of rollover within Lawler should not be construed as teaching the prevention of rollover. Otherwise, it would, in effect, be the position of the USPTO that all prior art references that do not describe the prevention of "rollover" should be considered as anticipatory.

Applicant respectfully requests the Examiner to reconsider the §102(e) rejection based on Lawler.

With respect to the remaining rejections, Applicant respectfully traverses these rejections. However, since the remaining rejections are not directed to dependent claims 7, 16, 25 and 34, Applicant respectfully submits that further discussion of the grounds for traversing these rejections is moot based on the allowability of the pending claims. Applicant reserves the right to prosecute and argue allowability of these claims if an appeal is warranted.

Conclusion

At the Examiner's earliest convenience, Applicant respectfully requests withdrawal of the outstanding rejections and issuance of a Notice of Allowance.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 07/22/04 By _____

William W. Schaal
Reg. No. 39,018
Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

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